

## REMARKS/ARGUMENTS

### Double Patenting

Applicants hereby submit a Terminal Disclaimer to address the Examiner's obviousness-type double patenting concerns with respect to U.S. Patent Nos. 6,709,682; 6,344,220; and 5,916,565. In view of this Terminal Disclaimer, Applicants believe that such rejections should be removed and that all Claims should be passed to allowance.

### Rejection of Claims 1-6 under 35 U.S.C. §103(a)

The Examiner contends that Claims 1-6 are unpatentable over a combination of Hirschhorn, Hobbs, Castleman, U.S. Patent No. 5,364,845 and U.S. Patent No. 3,887,703. Applicants respectfully contend that the Examiner's apparent need to combine the teachings of five separate references in order to fashion an obviousness rejection of the above-referenced claims is itself evidence of the non-obviousness of the claimed invention. Although the Examiner contends that each of the references teaches the use of one or more of the claimed components of the overall claimed composition to treat arthritis, there is simply no teaching or suggestion in any of such references to make the combination made by Applicants other than the guidance provided by the Applicants' disclosure. It is impermissible within the framework of §103 to pick and choose from multiple references only so much as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *See Polaroid Corp. v. Eastman Kodak Co.*, 229 USPQ 561 (Fed. Cir.), cert. denied, 471 US 850 (1996). It is entirely appropriate that combination claims can consist of combinations of old elements. *Clearstream Wastewater Sys. v. Hydroaction, Inc.*, 206 F.3d 1440, 1446, 54 USPQ 2d 1185, 1189-

1190 (Fed. Cir. 2000). "The notion that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, Section 103." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1575, 1 USPQ 2d 1593, 1603 (Fed. Cir. 1987). The showing of combinability must be "clear and particular." *In re Dembiczak*, 175 F.3d at 999, 50 USPQ 2d at 1617. The genius of invention is often a combination of known elements which in hindsight seems preordained. When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, tests of whether to combine references need to be applied rigorously. *McGinley v. Franklin Sports, Inc.*, 60 USPQ 2d 1001 (Fed. Cir. 2001). The relevant portions of a reference include not only those teachings which would suggest particular aspects of an invention to one of ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention. *In re Mercier*, 185 USPQ 774, 778 (CCPA 1975).

Applicants respectfully direct the Examiner to the fact that Hirschhorn solely relates to noted improvements seen in a group of 25 patients treated with Devil's Claw. Hirschhorn makes no reference whatsoever to any other components used in conjunction with Devil's Claw, and specifically, makes no reference to glucosamine salts. In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the references "must be read as a whole and consideration must be given to where the references diverge and teach away from the claimed invention". *Akzo N.V. v. United States Int'l Trade Commission*, 1 USPQ2d 1241 (Fed. Cir. 1986) *cert denied*, U.S. 909 (1987); *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir.), *cert denied*, 481 U.S. 1052 (1987).

Based upon the above-referenced well established law, it is not at all clear that the combination made by the Examiner would have been made by one of ordinary skill in the art, and it is even less clear whether the requisite motivation exists to make such combination. That individual arthritic treatments utilizing various different components is sufficient to provide such motivation is not at all "clear and particular". A motivation or suggestion to combine references must be explicit. *Winner Int'l Royalty Corp. v. Wang*, 48 USPQ 2d 1139 (D.C.D.C 1998). Such a motivation does not appear to exist in any of the references relied upon by the Examiner to reject the present claims and thus the Examiner has failed to present a *prima facie* case of obviousness..

Indeed, the Examiner admits that the particular amount of components claimed by the Applicants are not disclosed or suggested in any of the references. The Examiner attempts to remedy this deficiency by merely concluding that one of ordinary skill in the art would routinely optimize particular parameters. What the Examiner fails to note, however, is that the prior art would need to suggest how such optimization of particular ingredients would be employed. Given the relative narrowness of the claimed compositions and the distinctive quantitative amounts of each particular component, Applicants respectfully submit that no such disclosure, teaching or suggestion is provided in the prior art and that one of ordinary skill in the art would not have arrived at the particular quantitative or particular combination limitations of the particular combination of components as set forth in the claims. Applicants respectfully request that the Examiner reconsider and withdraw all such rejection of the claims.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. *ACS Hospital Sys. v. Montofiore Hospital*, 221 USPQ 929, 933 (Fed.Cir. 1974). It is well established that an

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evaluation of the obviousness or non-obviousness of claims must not be made with the benefit of hindsight using the present application as a blueprint to reconstruct the claimed invention from the references. *See Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed.Cir. 1985). The Examiner's examination of the present invention should not be predicated upon the obviousness of particular components but rather, should be based upon an evaluation of the invention as a whole, and in view of other relevant factors, such as the issued parent patents and the commercial success as discussed in the parent application (such arguments and data incorporated herein).

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw all §103 rejections.

Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned directly at (303) 863-2977.

Respectfully submitted,

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